

REMARKS/ARGUMENTS

These Remarks and amendments are responsive to the Office Action mailed May 20, 2005 (the "Office Action"). The Applicant respectfully requests reconsideration of the claim rejections for at least the reasons set forth below.

STATUS OF THE CLAIMS

Claims 1-4, 6-37 and 39 are pending in the application.

Claim 18 has been amended to add a missing semicolon.

Claims 32 and 33 have been amended to depend from claim 1.

Claims 34 and 39 have been amended to add features relating to insurance appointments, and no new matter is added.

CLAIM OBJECTIONS

The Examiner objected to claims 32 and 33 as being in improper dependent form. These claims have been amended to depend from system claim 1, and are thus believed to be in proper form. Reconsideration of this objection is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

The Examiner rejected all of the pending claims under 35 U.S.C. § 112 as allegedly failing to comply with the enablement requirement, and allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections stem from the Examiner's suggestion that the term "appointment" is unclear and/or not related to the subject matter of licensing information and determining compliance with state or federal licensing requirements. This rejection is respectfully traversed.

An "appointment" is a term of art generally meaning "an agreement between an insurer and a licensee authorizing the licensee to represent the insurer in the sale of its products." This definition is illustrated in the third-party document attached hereto as

Exhibit A, which also explains other features of appointments, such as the fact that fines can be levied against an agent or company selling insurance without an appointment.

In view of this definition, which is well known and commonly used in the field of insurance, the Applicant respectfully submits that the meanings of the claims are perfectly clear. For example, with regard to the term “appointment database,” this refers to a database listing appointment information — that is, listing agreements between insurers (the “suppliers” offering the “products”) and licensees. In view of the foregoing, reconsideration and withdrawal of the §112 rejections is respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Lederer and Hollingsworth

The Examiner rejected claims 1-4, 6-17, 37 and 39 under 35 U.S.C. § 103 as allegedly being unpatentable over Lederer *et al.* (U.S. Pub. No. 2002/0023109) in view of Hollingsworth (U.S. Pat. No. 6,157,808). As explained below, the Applicant respectfully traverses and request reconsideration of the rejection.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); and MPEP § 2143.01. The mere fact that references can be combined or modified does

not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Finally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The independent claims all distinguish over the cited art by reciting features relating to obtaining appointments information and/or maintaining an appointments database. As explained above, the term "appointments" is a term of art that refers to products that a licensee are authorized (*i.e.*, "appointed") to sell. Specifically, claims 1 and 39 recite the feature of an "appointments database adapted to contain a source of appointments information, said appointments information including at least information related to one or more products offered by one or more suppliers," and claim 1 further recites that the "licensee information" includes "information related to whether said licensee is appointed to sell at least one of said one or more products offered by said one or more suppliers." Claim 18 recites that the method includes the step of "obtaining appointments information from one or more suppliers, said appointments information being related to one or more products offered by said one or more suppliers," and "determining an extent to which said at least one entity is appointed to sell at least one of said one or more products offered by said one or more suppliers." Claim 34 recites the step of "obtaining appointments information from one or more suppliers, said appointments information being related to one or more products offered by said one or more suppliers, said appointments information being stored in said database." Claim 37 includes an appointments information feature in the recitation "wherein said licensee information further includes information related to

licensee appointments by a supplier of a product that may be sold be said at least one licensee.”

Neither Lederer nor Hollingsworth disclose or reasonably suggest these elements. Lederer is directed to a system for complying with local laws regarding shipping chemicals, and says nothing about whether particular persons or agencies are authorized to sell products. The Examiner admits that Lederer does not disclose a source of appointments information or that the Lederer system is for managing licensing information. Office Action at 6. Hollingsworth discloses a system for managing information regarding employees’ licensing and education. The Examiner does not cite to any disclosure of any appointments features in Hollingsworth, and no such feature is disclosed therein. Furthermore, as explained in detail in Applicant’s previous replies, Hollingsworth fails to describe any capability (*i.e.*, database and processor structures and organization) to store information relating to products offered by suppliers and determine whether a licensee is authorized (appointed) to sell such products, as required in claims 1, 18, 34, 37 and 39.

In view of the foregoing distinctions, Applicant respectfully submits that Lederer and Hollingsworth do not render independent claims 1, 18, 34, 37 and 39 obvious. Likewise, dependent claims 2-4, 6-17, 19-33, and 35-36 are also not obvious by reason of their incorporation of the patentable features of independent claims 1, 18 and 34 from which they depend.

Hollingsworth and NRS

The Examiner rejected claims 18-37 under 35 U.S.C. § 103 as allegedly being unpatentable over Hollingsworth in view of NRS (the “National Regulatory Services” website). As explained below, the Applicant again respectfully traverses and requests reconsideration of the rejection.

The relevant law of obviousness under 35 U.S.C. §103 is set forth above.

The NRS website states that NRS provides insurance services such as gathering information about appointments and submitting it to carriers and states. NRS also discloses that it gathers information regarding state license requirements and applications. Despite these disclosures, NRS has a severe limitation: it says *nothing* about performing these functions using an automated system. In fact, NRS appears to be *nothing more than an advertisement for the old manual system of determining licensing and appointment status*. The fact that NRS offers these services does not mean that they have or use the claimed *automated system and method* of the present invention.

Furthermore, the Examiner's alleged motivation to combine the references is lacking. The Examiner states that a motivation to combine the references exists simply in the fact that "a license is required to solicit, sell, negotiate or otherwise render advice relating to insurance products and every state is different when it comes to the requirements of obtaining licenses thus a compliance and consulting service would aid in this process." To begin with, neither reference suggests that it should be combined with the other "to aid in the process," as the Examiner alleges. As such, there is not motivation in the cited references art. Second, this alleged motivation overlooks the fact that the "compliance and consulting service" describes nothing more than a conventional manual service. If one were to combine the references, it would still only result in the computer-implemented system of Hollingsworth, with the additional manual features offered by NRS. As such the alleged combination is both improper (having no proper motivation to combine), and incomplete (failing to disclose the automated appointments features).

As such, Applicant respectfully submits that the combined teachings of Hollingsworth and NRS are not properly combined, and do not render obvious the methods and systems of claims 18-37. Favorable reconsideration is respectfully requested.

CONCLUSION

The Applicant respectfully submits that the application is in condition for allowance, and notification thereof is respectfully requested. If the Examiner believes that prosecution might be advanced by discussing the application with Applicant's counsel, in person or over the telephone, Applicant's counsel would welcome the opportunity to do so.


The appropriate extension of time fee is submitted herewith. In the event the provided payment is insufficient or in excess, the Commissioner is hereby authorized to charge or credit the undersigned's Deposit Account No. 50-0206 to correct any payment error.

Respectfully submitted,

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